

REMARKS

Claims 1 through 8 are pending in this Application. Claim 1 has been clarified by reciting that the conductive film is on a dicing line region, adequate descriptive support for which should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification, noting element 7 in Figs. 4, 6, 7, 9 and 11 through 15, for example. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1, 2, 4 and 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Chien.

In the statement of the rejection the Examiner referred to Fig. 4 of Chien, asserting the disclosure of a semiconductor device corresponding to that claimed and identifying, *inter alia*, electrode portion 201 on the main surface of chip 20. The Examiner also asserted, without identifying any factual basis, that the conductive film is not removed from the dicing line and that the conductive film remains as part of the structure in the pad area. The Examiner then pointed to dielectric 24 asserting it covers part of the conductive film along the peripheral lateral edges of chip 20. This rejection is traversed as factually inaccurate.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In imposing a rejection under 35 U.S.C. § 102 the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each and every feature of a

claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are significant differences between the claimed semiconductor device and Chien's semiconductor device that scotch the factual determination that Chien discloses a semiconductor device identically corresponding to that claimed.

Specifically, the semiconductor device defined in claim 1 comprises, *inter alia*, a conductive film on a dicing line region and an insulating sheet covering part of the conducting film along the periphery of the semiconductor chip. No such structure is disclosed or suggested by Chien. It is not apparent and the Examiner did not comply with the judicial requirement of identifying wherein Chien discloses a semiconductor device comprising a chip with a conductive film present on a dicing line region. *In re Rijckaert*, *supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, *supra*. In this respect Applicants would note that pad 201 is **not** formed in a dicing region and is **not** equivalent to the conductive film on the dicing line region as in the claimed invention.

Applicants separately and vigorously argue the patentability of **claim 2**. Dependent claim 2 specifies that an insulating sheet member is provided to cover the back face of the chip, a side face of the chip and part of the front face along the periphery of said semiconductor chip. It is not apparent and the Examiner has failed to identify wherein Chien discloses or suggests any such element. *In re Rijckaert*, *supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, *supra*. In this respect Applicants would note that epoxy applied to the back face of the chip is

identified by Chien as element 28 (Fig. 4). Element 28 is different from dielectric layer 24 and also serves a different purpose.

The Examiner asserts that dielectric layer 24 covers part of the front face of the chip. However, dielectric layer 24 is **not**, repeat **not**, on the back face of the chip and epoxy layer 28 is **not**, repeat **not**, on the front face of the chip or the side of the chip. Accordingly, neither of these elements 28, 24, corresponds to the insulating sheet member of claim 2.

The above argued structural differences between the claimed devices and Chien's device undermine the factual determination that Chien discloses a semiconductor device identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 2, 4 and 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Chien is not factually viable and, hence, solicit withdrawal thereof.

Claims 3 and 6 through 8 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Chien in view of Duesman et al.

This rejection is traversed. Specifically, claims 3 and 6 through 8 depend from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Chien. The secondary reference to Duesman et al. does not cure the argued deficiencies of Chien. Accordingly, even if Chen's device is modified as suggested by the Examiner, and Applicants do not

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agree that the requisite fact-based motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).


Applicants, therefore, submit that the imposed rejection of claims 3 and 6 through 8 under 35 U.S.C. § 103 for obviousness predicated upon Chien in view of Duesman et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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